

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above in the comments which follow. As correctly noted the Office Action Summary, claims 37-66 were pending. By the present Response, claims 67-79 have been added, claims 37-39, 51-53 and 62 have been amended, and claims 40-52, 55-61 and 63-66 have been canceled. Thus, upon entry of the present Response, claims 37-39, 51-54, 62 and 67-77 are pending and await further consideration on the merits.

Support for the present claim amendments can be found for example, in at least the following portions of the original disclosure: page 7, the table appearing therein; page 7, lines 25-27; page 8, lines 12-15; page 9, line 1; page 9, line 28; page 10, line 25 – page 11, line 28; page 18, line 1; page 21, lines 1-24; page 23, lines 11-14; and page 23, line 28.

Entry of the foregoing is appropriate pursuant to 37 C.F.R § 1.116 for at least the following reasons. First, the foregoing claim amendments act to clearly overcome the grounds for rejection and place the application in condition for allowance; the foregoing claim amendments do not raise issues that would necessitate a new search; and the foregoing claim amendments act to place the application in better form for an appeal.

Applicant thanks Examiner Phan for the courtesies extended to the inventor and Applicant's representatives during a personal interview conducted on September 15, 2005. During the interview, the grounds of rejection of record were discussed, as well as how the presently amended claims are clearly supported by the disclosure. In addition, the presentation of a Terminal Disclaimer to obviate the obviousness-type double patenting rejection of record was also discussed.

CLAIM REJECTIONS UNDER 35 U.S.C § 112, FIRST PARAGRAPH

Claims 37-66 stand rejected under 35 U.S.C § 112, first paragraph on the grounds set forth in paragraph 2 of the Official Action. In particular, the aforementioned claims are rejected "because the best mode with the enablement requirement contemplated by the inventor has not been disclosed." The above-stated grounds for rejection, as it would be applied to the claims as currently amended, is respectfully traversed.

The present invention is directed to a device configured to predict a disease control parameter based upon previous disease control parameter values, self care values of the patient, optimal self care values of patient, and one or more scaling factors.

A device constructed according to the principles of the present invention is set forth in amended claim 37. Amended claim 37 recites:

An electronic device for outputting a signal configured according to at least one disease control parameter value of a patient, comprising: (a) an electronic data recording device configured for receiving a prior disease control parameter value; (b) a memory comprising one or more optimal disease control parameter values, self-care values of a patient, optimal self-care values, and one or more scaling factors; (c) a microprocessor, in communication with said electronic data recording device and said memory, programmed to calculate a further disease control parameter value, said further value being based on said self-care values, said disease control parameter values, and said scaling factors; and (d) a display configured to display information according to said further value, thereby enabling the patient to select appropriate self care actions.

The presently claimed invention is fully enabled by the original disclosure. In this regard, the Examiner's attention is directed to the support contained in the original specification as identified by page and line number above. In addition, it is asserted in paragraph 2 of the Official Action that the specification fails to enable the previously recited feature of "to prevent hypoglycemia or hyperglycemia." By the present Response, the above-quoted feature has been removed from the claims. Moreover, the additional features identified in paragraph 2 of the Official Action have also been removed from the claims. For at least the reasons noted above, the presently claimed invention is fully enabled, and supported, by the original disclosure. Reconsideration and withdrawal of the rejection is respectfully requested.

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Claims 37-66 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-32 of U.S. Patent No. 5,965,501 (hereafter "*the 501' patent*") on the grounds set forth in paragraph 2 of the Official Action.

Applicants traverse this ground for rejection. In particular, significant differences exist the presently amended claims, and the claims appearing in the '501 patent. Moreover, the grounds for rejection fail to identify these differences, much less explain how these differences would have been obvious to one of ordinary skill in the art, as is required to formulate an appropriate double-patenting rejection.

Nevertheless, in order to expedite prosecution, Applicants submit herewith a duly executed Terminal Disclaimer in order to obviate the above-noted obviousness-type double patenting rejection.

CONCLUSION

Based on the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instance application expedited.

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Respectfully submitted,

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